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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,726	09/23/2003	Jerald L. Baughman	PC-1511	2461
7590	02/24/2006		EXAMINER LEWIS, RALPH A	
Law Offices of Brian S. Steinberger Registered Patent Attorneys 101 Brevard Avenue Cocoa, FL 32922			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/668,726	BAUGHMAN, JERALD L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ralph A. Lewis	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-16 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09232003</u> . | 6) <input type="checkbox"/> Other: ____  |

### **Obvious-type Double Patenting Rejections**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-20, 23 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims 1-13 of U.S. Patent No. D508,563 S and D508,996 S. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patents claim all of the subject matter of the present claims. See MPEP 804.II.B.3 on page 800-28.

### **Rejections based on 35 U.S.C. 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Dependent claim 9 calls for the claimed "light source" of claim 1 to be "natural sunlight." The claim appears to suggest that applicant is positively claiming the sun itself (the source of natural sunlight) as part of his invention. While *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980) famously declared that patentable subject matter under 35 U.S.C. 101 "include[s] anything under the sun that is made by man" 447 U.S. at 309, they did not include things made by man in combination with the sun itself.

#### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, "natural sunlight" is not a "light source" it is "light."

#### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 17-20, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilbert (US 557,664).

Gilbert discloses a mouthpiece of oval shape "to distend and be retained in position by the lips and reflect light upon the teeth (natural or artificial) in the mouths of patients" (column 1, lines 13-16). The Gilbert mouthpiece and disclosed light source are capable of whitening teeth.

Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen et al (US 6,391,283).

Jensen et al disclose a mouth piece 32 which when place in the patients mouth exposes the teeth to light source 42 which activates a teeth whitening composition on the patient's teeth.

Claims 1-4, 17-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Good (US 5,487,660).

Good discloses a mouthpiece 10 having a generally oblong oval shape with upper lip support 20 and lower lip support 22 which exposes teeth to light. The mouthpiece includes a tab 24 for allowing the user to bite down on the mouth piece. In

regard to claim 1, presuming that the orthodontist is not working in total darkness then there is a light source present.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US 557,664).

In regard to claims 5 and 21, Gilbert indicates that the disclosed mouth piece is made of metal rather than the claimed "plastic." However, one of ordinary skill in the art would have found it obvious to have constructed the Gilbert mouthpiece out of conventional every day plastic in order to reduce the manufacturing costs.

In regard to claims 7-9, Gilbert does not explicitly disclose the source of the "(natural or artificial)" light (column 1, line 15), however, one skilled in the art would readily recognize that dental offices typically have ultraviolet lights, bright working lights as well as windows that allow for natural lighting. To have provided for such conventional lighting with the Gilbert device would have been obvious to the ordinarily skilled artisan as a matter of routine.

Claims 5, 7-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good (US 5,487,660).

In regard to claims 5 and 21, Good does not disclose the material of his mouth piece. However, one of ordinary skill in the art would have found it obvious to have constructed the Good mouthpiece out of conventional every day plastic as the selection of a common convention material in which to make such an article.

In regard to claims 7-9, Good does not explicitly that the orthodontist/dentist uses light to see what he is doing, however, one skilled in the art would readily recognize that dental offices typically have ultraviolet lights, bright working lights as well as windows that allow for natural lighting. To have provided for such conventional lighting with the Good device would have been obvious to the ordinarily skilled artisan as a matter of routine.

### **Allowable Subject Matter**

Claims 10-16 are allowed. In regard to claims 10-16, the prior art of record is silent with regard to a method of positioning a mouthpiece into the mouth of a user for exposing the upper and lower frontal teeth and then whitening the exposed teeth from a light source while at the same receiving a body tan from the light source as it is required by the present claims. The closest art to which the examiner could approach such a method is perhaps a person (e.g. a camper) brushing his/her teeth outside in the sun with a toothpaste having a whitening formula that inherently activates with light (e.g. hydrogen peroxide), but the examiner is of the position that a toothbrush doesn't

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reasonably meet the conventional definition of a "mouthpiece" as the term is used in the art, nor does a toothbrush work to expose the upper and lower frontal teeth.

### **Prior Art**


Applicant's information disclosure statement of September 23, 2003 has been considered and an initialed copy enclosed herewith.

Hare (US 770,853), Inoue (US 4,200,089), Scheer (US 4,592,344), Hammesfahr (US 4,867,682), Horiguchi (US 6,500,002), Rizoio et al (US 6,616,447) and West et al (US 6,733,290) are made of record.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis  
February 17, 2006

  
Ralph A. Lewis  
Primary Examiner  
Au 3732